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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,108	07/24/2003	Brent L. Davis	BOC9-2003-0006 (375)	8969
40987	7590	03/03/2006		
AKERMAN SENTERFITT P. O. BOX 3188 WEST PALM BEACH, FL 33402-3188			EXAMINER GAUTHIER, GERALD	
			ART UNIT	PAPER NUMBER
			2645	

DATE MAILED: 03/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,108

Applicant(s)

DAVIS ET AL.

Examiner

Gerald Gauthier

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 11-13 and 16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 11-13 and 16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. **Claim(s) 1-6, 11-13 and 16**, drawn to manage messages in a voicemail system, classified in class 379, subclass 88.22.
 - II. **Claim(s) 7-10, 14, 15 and 17**, drawn to convert message from text to voice in a multimedia system, classified in class 379, subclass 88.13.
2. The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because there is no conversion of messages from text to voice. The subcombination has separate utility such as text-to-speech conversion.
3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Richard A. Hinson on February 22, 2006 a provisional election was made without traverse to prosecute the invention of group I,

claim(s) 1-6, 11-13 and 16. Affirmation of this election must be made by applicant in replying to this Office action. Claim(s) 7-10, 14, 15 and 17 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Response to Amendment

5. The declaration filed on December 12, 2005 under 37 CFR 1.131 is sufficient to overcome the Adamczyk, Washburn and Whynot references.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. **Claim(s) 1-6, 11-13 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiswani et al. (US 6,160,995) in view of Hanson et al (US 6,697,474 B1).

Regarding **claim(s) 1 and 16**, Kiswani discloses a method to enable instant collaboration via the use of pervasive messaging (FIG. 1 and column 1, lines 6-9), comprising the steps of:

receiving a call from a caller to a callee (FIG. 5 and column 4, lines 33-38);
transferring the call to a voicemail system when the callee is unavailable (column 4, lines 40-46); and
querying the caller if they want to leave one among a voice message and an instant message (column 4, lines 48-53).

Kiswani discloses prompting the caller for a text message but fails to disclose determining if the callee is available via instant messaging.

However, Hanson in the same field of endeavor teaches determining if the callee is available via instant messaging (FIGS. 7-9 and column 8, lines 57-63) [The ACP 125 queries the database to determine if the user is currently on line for an instant messaging service].

Therefore, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to modify the invention of Kiswani using the teaching automated call processor as taught by Hanson.

This modification of the invention enables the system to determine if the callee is available via instant messaging so that the user would receive a telephone call via its instant messaging client.

Regarding **claim(s) 2**, Hanson teaches a method wherein the method further comprises the step of recording a voice message from the caller to the callee and transcribing the voice message to a text message when the caller selected the instant message as an option (column 8, lines 55-63).

Regarding **claim(s) 3**, Hanson teaches a method, wherein the method further comprises the step of sending the text message to the callee via the instant messaging system (column 8, lines 55-63).

Regarding **claim(s) 11**, Kiswani in combination with Hanson disclose all the limitations of **claim(s) 11** as stated in **claim(s) 1**'s rejection and furthermore Kiswani discloses a voicemail system (330 on FIG. 3);

an instant messaging system coupled to the voicemail system (330 on FIG. 3);
and a processor (330 on FIG. 3).

Regarding **claim(s) 13**, Kiswani discloses a system wherein the processor resides within the voicemail system (330 on FIG. 3).

Regarding **claim(s) 4**, Hanson teaches a method, wherein the method further comprises the step of translating the text message to provide a translated text message and sending the translated text message to the callee via the instant messaging system (column 8, lines 55-63).

Regarding **claim(s) 5**, Hanson teaches a method, wherein the method further comprises the step of querying the caller as to when an instant message should be delivered when the caller selected the instant message as an option (column 8, lines 55-63).

Regarding **claim(s) 6 and 12**, Hanson teaches a method, wherein the method further comprises the step of delivering the instant message to the callee at a predetermined scheduled time as directed by the caller (column 9, lines 28-42).

Response to Arguments

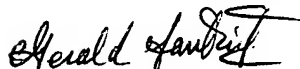
5. Applicant's arguments with respect to **claim(s) 1-6, 11-13 and 16** have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gerald Gauthier whose telephone number is (571) 272-7539. The examiner can normally be reached on 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (571) 272-7547. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


GERALD GAUTHIER
PATENT EXAMINER

gg
February 23, 2006